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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/064,973	04/23/1998	MICHAEL F. VIDOLIN	044073-0281635	6821

909 7590 05/19/2003

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EXAMINER

MILLER, WILLIAM L

ART UNIT PAPER NUMBER

3677

DATE MAILED: 05/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/064,973

Applicant(s)

VIDOLIN ET AL.

Examiner

William L. Miller

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 27-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 41 and 42 is/are allowed.
- 6) ☐ Claim(s) 27-29,32-34,36-39 is/are rejected.
- 7) ☒ Claim(s) 30,31,35 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03-24-2003 has been entered.

### *Claim Objections*

2. Claims 27, 41, and 42 are objected to because of the following informalities: claim 27, line 7 - change "a" to --the--; claim 41, line 3 - change first recitation of "a" to --the--; claim 41, line 9 - change third recitation of "a" to --the--; claim 42, line 3 - change first recitation of "a" to --the--; and claim 42, line 7 - change first recitation of "a" to --the--. Appropriate correction is required.

### *Claim Rejections - 35 USC § 112*

3. Claim 32 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Moreover, Fig. 4 does appear to show the right-side closure element 44c having a cross-section that is larger than the loop opening of each closed loop member, however, the original claims, drawings, and/or specification fail to show or describe each closed loop member being elastically expanded to pass over the above said closure element so as to remove each closed loop member

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from the friendship band. According to Fig. 4, it appears more probable each closed loop member would slidably pass over the smaller left-side closure element 44c, without elastic expansion, so as to remove each closed loop member from the friendship band.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 27, 33, 34, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Winn (US#Des.158918). See marked-up Figs. 1-2.

6. Regarding claim 27, Winn discloses a friendship band with a plurality of closed loop members comprising: a band section made of a first material that is flat in cross-section; a closure means attached to first and second ends of the band; and the plurality of closed loop members being mounted on the band, each closed loop member being made of a second material that is flat in cross-section, having a loop opening conforming the band cross-section, including indicia, and being removable, i.e. capable of being removed, from the first or second ends of the band.

7. Although Winn fails to specifically disclose the closed loop members being exchangeable with closed loop members of other friendship bands, the closed loop members of other friendship bands are not being positively claimed and represents the intended use of the band. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from

the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In the instant case, the closed loop members are capable of being exchanged with closed loop members of other friendship bands.

8. Regarding claim 33, the indicia is being viewed as an insignia or emblem.

9. Regarding claim 34, the applicant is reminded method limitations, such the indicia being embroidered onto the closed loop member, are given little patentable weight in an article claim as the patentability of a product does not depend on its method of production. See MPEP 2113.

10. Regarding claim 37, the length dimension of the band is greater than its width dimension and thus the band is being viewed as elongated. The elongated band is capable of being worn as a necklace on a structure having a suitably dimensioned neck portion.

#### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 28 and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Winn in view of Kuroda (US#4060185).

13. Regarding claim 28, Winn fails to disclose the first material (band) being elastic as claimed by the applicant. Kuroda discloses a similar friendship band including an elastic band section 1,6 (abstract) for improved comfort. Therefore, as taught by Kuroda, it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify Winn by utilizing an elastic band section thereby improving comfort.

14. Regarding claim 29, Koruda discloses the band portion 6 is made of rubber.
15. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Winn.
16. Winn fails to specifically disclose the first and second material as being the same material, however it would have been an obvious design choice to utilize the same material for the first and second materials as the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).
17. Claims 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winn in view of Schmidt (US#4753086).
18. Regarding claim 38, Winn fails to disclose an outer surface layer enclosing the band section as claimed by the applicant. Schmidt discloses a similar friendship band including an outer surface layer 30 enclosing band section 11 whereby the outer surface layer is interchangeable thus providing decorative options. Therefore, as taught by Schmidt, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Winn by including an outer surface layer enclosing the band section whereby the outer surface layer was interchangeable thus providing further decorative options.
19. Regarding claim 39, although Schmidt discloses the outer surface layer as a fabric material, Schmidt fails to disclose the specific outer surface layer material as claimed by the

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applicant. However, it would have been an obvious design choice to utilize one of the specific claimed materials as the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

***Allowable Subject Matter***

20. Claims 30, 31, 35, and 40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

21. Claim 32 would be allowable upon overcoming the rejection(s) under 35 U.S.C. 112, first paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

22. Claims 41 and 42 are allowed.

***Response to Arguments***

23. The applicant argues the invention did have possession of the invention as claimed in claim 32. The examiner disagrees as nowhere in the original disclosure was it stated and/or shown that each closed loop member was elastically expanded to pass over the closure means having a cross-section larger than the loop opening in order to remove each closed loop member from the band.

24. Applicant's arguments with respect to Doppenschmitt (US#1694703) and Knodel (US#4179833) have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

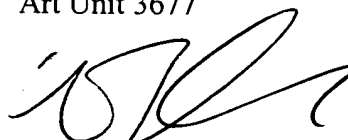
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is 703 305 3978. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703 306 4115. The fax phone numbers for the organization where this application or proceeding is assigned are 703 872 9326 for regular communications and 703 872 9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

William L. Miller  
Primary Examiner  
Art Unit 3677



wlm  
May 14, 2003



June 6, 1950

E. L. WINN

Des. 158,918

COMBINED WATCH BRACELET AND WATCH

Filed Feb. 10, 1950

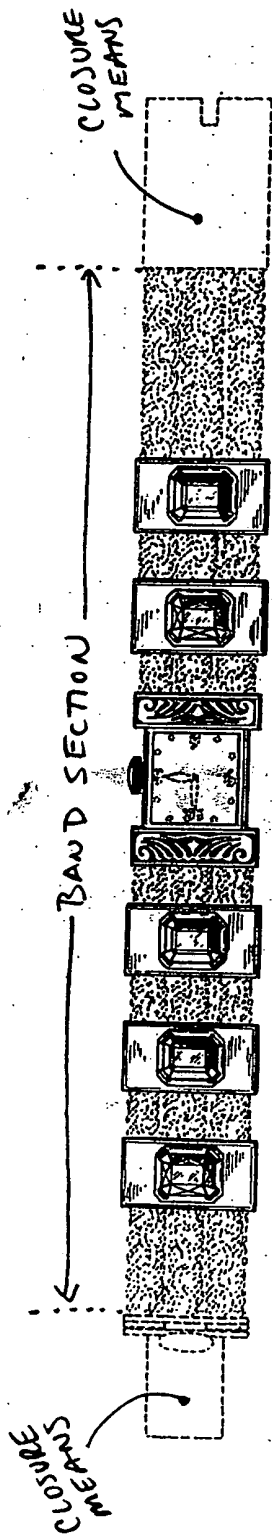


Fig. 1.

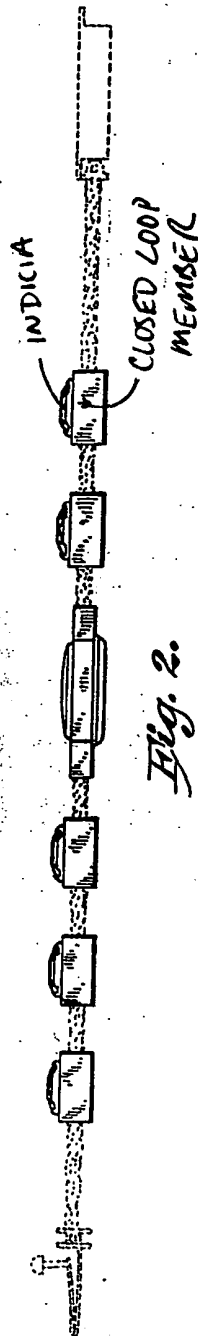


Fig. 2.

INVENTOR.  
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